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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/304,035	05/03/1999	GIORGIO J. VANZINI	MSI-254US	9156
22801	7590	10/05/2004	EXAMINER	
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			KIM, AHSHIK	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/304,035

Applicant(s)

VANZINI ET AL.

Examiner

Ahshik Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07/15/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-6,22-26,39-48,50,52 and 53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-6,22-26,39-48,50,52 and 53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Amendment*

1. Receipt is acknowledged of the amendment filed on July 15, 2004. In the amendment  
5 claims 49 and 51 are canceled, and claim 50 was amended. Currently, claims 1, 4-6, 22-26, 39-  
48, 50, 52, and 53 remain for examination.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the  
10 basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on  
sale in this country, more than one year prior to the date of application for patent in the United States.

15 3. Claims 1, 4-6 and 22-26, 45-48 50, 52, and 53 are rejected under 35 U.S.C. 102(b) as  
being anticipated by Harari et al. (US 5,887,145, hereinafter “Harari”).

Re claims 1, 22, and 50, Harari teaches a PCMCIA form factor device 10 (col. 3, lines  
19-23; col. 6, lines 63+) comprising an interface 14 to communicate with a storage card 20 and a  
flash memory 60 (see figure 7). The daughter card 20 is a removable smart card. The card  
20 assembly 100 can be connected to a host machine/system (see abstract; col. 1, lines 13+).

Re claims 23 and 48, the storage card contains various chips such as flash EEPROM  
memory (col. 7, lines 24+).

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Re claims 4, 5, and 24, the storage card 20 further contains identifying data readable from the mother card or the host, which in turn can be used in guiding the host to use a particular device protocols or software (col. 5, lines 38+).

Re claims 6, 25, 26, 45-47, 52, and 53, the daughter card 30 stores an assignable identity code and a secret key (private key in RSA public-key data encoding scheme) (col. 13, lines 64+). Only when the private-public keys are matched, the information can be decrypted and read.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 39-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harari et al. (US 5,887,145) in view of Ban et al (US 6,148,354, hereinafter "Ban"). The teachings of Harari have been discussed above.

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Although Harari discloses an interface 54 to the host machine (col. 7, lines 54+), Harari fails to specifically teach or fairly suggest that one of the interfaces is USB interface.

Ban teaches a flash memory card comprising USB interface (i.e., USB connector, USB logical/physical interface and USB functional interface) (see figure 6; col. 1, lines 43+; col. 4,  
5 lines 59+).

In view of Ban's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to alternately employ well-known USB interface to the teachings of Harari in order to communicate with host machine which uses USB standard. USB interface is often smaller in size and easier for the end users. Moreover, it is the Examiner's view that  
10 communication protocol such as PCMCIA interface, USB interface, SCSI and RS232 interface are functionally equivalent in that host and the card can communicate using any of the communication protocols. Accordingly, one ordinary skill in the art would choose an interface best fitting the needs of the one's embodiment.

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### ***Response to Arguments***

7. Applicant's arguments filed on July 15, 2004 have been carefully considered, but they are not persuasive.

It is the Examiner's view that the Harari patent discloses what Applicant claims  
20 particularly in claims 1, 22, and 50. In Harari, relying on the main figure (on the front page of the patent), 100 is an assembly comprising a PCMCIA form factor card 10 comprising a flash memory (see figure 7), and an interface 14 to accept a smart card 20. Although Applicant cites that the mother card 10 does not contain any substantial amount of flash EEPROM mass storage

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(see the section under 35 U.S.C. § 102 (b)), another embodiment of Harari indicates that main memory of the mother card 10 can be a flash memory (col. 9, lines 10+).

The amended claims and remarks describing these elements have been fully considered, but in view of the above, it is the Examiner's view that cited references, taken alone or in combination, teaches the subject matter disclosed in the instant application. Therefore, the Examiner has made this Office Action final.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ahshik Kim whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday. The fax number directly to the Examiner is (571)273-2393.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax phone number for this Group is (703)872-9306.

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Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim  
Patent Examiner  
Art Unit 2876  
September 29, 2004



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